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EXAMINER

KING, ANITA M

ART UNIT

PAPER NUMBER

3632

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/654,408

Applicant(s)

DUFFY ET AL.

Examiner

Anita M. King

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2005 and 16 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 4-11, 14, 15 and 18-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 12, 13, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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This is the second office action for application number 10/654,408, Folding Cantilever Support and Method, filed on September 3, 2003.

Election/Restrictions

Claims 4-11, 14, 15, and 18-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on October 20, 2004.

Drawings

The drawings were received on March 10, 2005. These drawings are accepted.

Claim Rejections - 35 USC § 112

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is an inconsistency between the language in the preamble and certain portions in the body of the claim, thereby making the scope of the claim unclear. The preamble in claim 1 clearly indicates that a subcombination is being claimed, e.g., "a portable device for supporting a load in a cantilevered disposition relative to a generally horizontal extant structure...." This language would lead the examiner to believe that the applicant intends to claim only the subcombination of "a portable device," the load

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and the horizontal extant structure being only functionally recited. This presents no problem as long as the body of the claim also refers to the horizontal extant structure functionally, such as, "for attachment to said horizontal extant structure."

The problem arises when the horizontal extant structure is positively recited within the body of the claim, such as, "wherein said platform portion extends in a generally horizontal disposition relative to said extant structure," cited in claim 2. There is an inconsistency within the claim; the preamble indicates subcombination, while in at least one instance in the body of the claim there is a positive recital of structure indicating that the combination of a device and a horizontal extant structure are being claimed. The examiner cannot be sure if applicant's intent is to claim merely the device or the device in combination with the horizontal extant structure.

Applicant is required to clarify what the claims are intended to be drawn to, i.e., either the device alone or the combination of the device and the horizontal extant structure. Applicant should make the language of the claim consistent with applicant's intent. In formulating a rejection on the merits, the examiner is considering that the claims are drawn to the subcombination (the portable device) and the claims will be rejected accordingly. If applicant indicates by amendment that the combination claim is the intention, the language in the preamble should be made consistent with the language in the body of the claims. If the intent is to claim the subcombination, then the body of the claims must be amended to remove positive recitation of the combination.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3, 12, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 3,074,745 to Bruckhalter. Bruckhalter discloses a portable device (11) for supporting a load in a cantilevered disposition and capable of supporting the load relative to a generally horizontal extant structure, the device comprising: a platform portion (12); a bracing portion (rear section of element 12) for transferring the moment reaction caused by the load; at least one hanging bracket (15) connecting the device to a surface of a structure (10); wherein the hanging bracket is pivotably attached (Col. 2, line 18ff) to the platform portion and to the bracing portion at a first axis; and wherein the platform portion extends from the structure in a generally sloped disposition; at least one lateral restraining member (12).

Claim 16 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 1,878,864 to Lane et al., hereinafter, Lane. Lane inherently teaches the method of supporting a load in a cantilevered disposition from an extant horizontal structure (10) comprising: providing a device (14) which includes at least a platform portion (15), a bracing portion (25), and a pivotably attached hanging bracket (22) connected at a first axis (@21); providing an extant horizontal structure having an edge (12), a top surface (11), and a bottom surface; extending a distal end (@23) of the hanging bracket away from the platform portion and the bracing portion; hanging the distal end of the hanging bracket from the top surface adjacent to edge of the extant structure; and engaging the

bracing portion with the bottom surface of the extant horizontal structure (Fig. 5) in an area remote from the edge.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bruckhalter in view of U.S. Patent 6,045,159 to Bellah. Bruckhalter discloses the claimed invention except for the limitation of a flexible linear element attached to the device. Bellah teaches a device having a platform having at least one flexible linear element (60) attached to the device at only one end. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the device in Bruckhalter to have included the flexible linear element as taught by Bellah for the purpose of providing for marking a page of book when supported by the device.

Response to Arguments

Applicant's arguments filed March 10, 2005 have been fully considered but they are not persuasive. The rejections advanced against the claims stand.

In response to applicant's argument that Bruckhalter's device is for a steering wheel, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to

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patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

In response to applicant's arguments, the recitation a load being supporting in a cantilevered disposition relative to a generally horizontal extant structure has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a book, a extant horizontal shelf, and horizontal forces) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that Bruckhalter does not provide a lateral restraining member as claimed by applicant, the examiner disagrees, Bruckhalter does indeed claim a lateral restraining member that is capable of restraining an object such as a book (which is not an element of the claimed invention) depending on the size and weight of the book.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Bellah is used to teach a flexible linear element only which can be used for marking a page in a book of a predetermined size and weight capable of being supported by the device in Bruckhalter.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the


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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anita M. King whose telephone number is (571) 272-6817. The examiner can normally be reached on Monday-Thursday.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Anita M. King
Primary Examiner
Art Unit 3632

April 3, 2006